



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,044	12/08/2005	Takehiko Tojo	281680US3PCT	9436
22850	7590	05/08/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
STETZ, RACHEL RUNNING				
ART UNIT		PAPER NUMBER		
3732				
NOTIFICATION DATE		DELIVERY MODE		
05/08/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/560,044

Applicant(s)

TOJO ET AL.

Examiner

Rachel R. Steitz

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7-10 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 4, 2009 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

3. It appears that Japan 2004-015222 is the Japanese patent application of US 10/560,044. Japan 2004-008099 does not appear to be related to application 10/560,044 therefore it will not receive the foreign priority date 1/15/2004, because without a foreign translation it appears based on the drawings of 2004-008099 is a species of the application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 7-9, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (PCT WO 03/00752).

Regarding claim 1, Kobayashi et al. disclose a hair holder comprising a flat tube having a sheet which forms a first side and a sheet which forms a second side to allow a hair bundle to be inserted from an opening at one end toward an opening at the other end such that when the hair holder is rolled up the sheet which forms the first side is on an outside of the tube. The sheet which forms the first side of the tube is more extensible in the length direction than the sheet which forms the second side of the tube and the sheet which forms the second side of the tube as a Taber stiffness of 0.4 mNm (see Figure 22). The sheet which forms the first side has a large number of openings to make the sheet extendable (see Figure 8). Regarding claim 5, the sheet is permeable to a hair treating agent. Regarding claim 7, the tube is designed to roll itself up into a prescribed shape.

Regarding claim 8, Kobayashi et al. disclose the method of treating hair including a flat tube having a sheet which forms a first side and a sheet which forms a second side the sheet which forms the first side of the tube is more extensible in the length direction of the tube than the sheet which forms the second side of the tube, the sheet which forms the second side of the tube has a Taber stiffness of 0.4 mNm or higher, and the method includes inserting a hair bundle through the tube of the hair holder and rolling up the tube having the hair therein (see Figures 24a-24d). Regarding claim 16, the device has reinforcing strip in the hair holder (see Figures 17a and 17b).

Kobayashi et al. disclose the claimed invention except for the first side of the sheet having at least 15 times higher of an extension under a load of 5 N as of the second sheet, the sheet which forms the first side having an extension of at least 5% under a load of 5 N, the sheet which forms the second side has an extension of 5% or less under a load of 5 N, the sheet which forms the first side has the extensibility of at least 30 times the extensibility of the sheet which forms the second side under the load of 5 N.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first side of the sheet be at least 15 times higher of an extension under a load of 5 N than the second sheet, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheet which forms the first side be an extension of at least 5% under a load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to one having ordinary skill in the art at the time the invention was made to have the sheet which forms the second side have an extension of 5% or less under a load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It further would have been obvious to

one having ordinary skill in the art at the time the invention was made to the sheet which forms the first side has the extensibility of at least 30 times the extensibility of the sheet which forms the second side under the load of 5 N, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

6. Applicant's arguments filed March 4, 2009 have been fully considered but they are not persuasive.
7. In response to applicant's argument that the sheet which forms the first side of the claimed invention is arranged opposite to the side of the sheet 223A of Kobayashi, however, Kobayashi discloses that the tube can be rolled up smoothly with whichever of the sheets 223A and 223B located on the inside (paragraph 0132).
8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., arranging the sheet which is easy to extend on the outer side) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
9. In response to applicants argument that Kobayashi teaches away from having the sheet with the Taber stiffness of 0.4 mNm or higher on the inner side, however, Kobayashi discloses that either side can be rolled up smoothly (paragraph 0132).

10. In response to applicants argument that Kobayashi does not disclose the claimed ratio of extensibility because it does not recognize a result-effective variable, however, one having ordinary skill in the art would recognize the load which is an outside source applied to the hair holder would change the extensibility therefore, Kobayashi does disclose a result-effective variable that can be optimized.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel R. Steitz whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/
Examiner
Art Unit 3732